

## REMARKS

### I. General

Claims 1-34 are pending.

Claims 1-4, 7-14, 17-25 and 28-34 were rejected.

Claims 5-6, 15-16 and 26-27 were objected.

Claims 1-4 and 7-12 were rejected under 35 USC § 103(a) as being unpatentable over Diebboll (US 5,886,643) in view of Impson (US 2003/0187571).

Claims 13-34 were rejected under 35 USC § 102(b) as being anticipated by Boyd (US 2002/0116491).

Claims 5-6, 15-16 and 26-27 were objected to as being dependent upon a rejected base claim.

Applicant has amended claims 1, 13 and 24.

### II. Rejections of Claims 1-4 and 7-12 under 35 USC § 103(a) as being unpatentable over Diebboll (US 5,886,643) in view of Impson (US 2003/0187571)

The examiner bears the burden to prove *prima facie* conclusion of obviousness; M.P.E.P. § 2142, *In re Peehs*, 612 F.2d 1287, 204 USPQ 835, 837 (CCPA 1980). To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Applicant has amended claim 1, to include the limitation the smart probes must comply with IEEE 1451 standard, a fact supported in the original specification. IEEE 1451-compliant smart probes have self-configuring, self-aware capabilities that would enable varying levels of data processing and decision-making to be made at the probes. The probes disclosed by Diebboll possess no such autonomous capabilities. Diebboll's probes are simple measurement points, with no inherent processing capabilities, that are reliant on a

central location for instructions. Impson, the other reference, teaches a totally different subject matter unrelated to IEEE 1451-standard probes i.e. determining a set of conditions for the smart probes prior to said measuring. By not teaching the identified limitation in claim 1, the combination of Diebboll and Impson does not make the claim obvious under 35 USC § 103(a). Rejection against claim 1 should therefore be withdrawn and the claim allowed. Claims 2-4 and 7-12 depending from claim 1, inherit all the limitation of the latter, should similarly be allowed.

**III. Rejections of Claims 13-34 under 35 USC § 102(b) as being anticipated by Boyd (US 2002/0116491)**

Paragraph 4 of the final office action cited rejections to claims 13-34 but did not include details of the rejections to claims 15-16 and 26-27. Applicant believes the office action actually meant to cite rejections to claims 13-14, 17-25 and 28-34 because claims 15-16 and 26-27 were objected to in paragraph 5.

Rejecting a claim under 35 U.S.C. § 102 requires each element of the claim to be disclosed by a single piece of prior art. See *W.L. Gore & Assoc., Inc v Garlock., Inc* 721 F.2d 1540, 220 USPO 303 (Fed. Cir. 1983). Anticipation requires each and every element as set forth in the claim, either expressly or inherently described, in a single prior art reference. See *MPEP § 2131*. Alternatively, anticipation requires each and every element in the claimed invention to be embodied in a single prior device or practice. See *Minnesota Min. & Mfg. Co. v Johnson & Johnson Orthopedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). Another important consideration is there must not be any difference between the claimed invention and the prior art disclosure, as viewed by an ordinary person skilled in the art of the invention, for the anticipation to be effective.

Claims 13 and 24 have been amended to include the limitation the smart probes must comply with IEEE 1451 standard, a fact supported in the original specifications. IEEE 1451-compliant smart probes have autonomous data-processing and decision-making capabilities otherwise absent in normal probes. Boyd does not disclose the IEEE 1451-standard smart probes and hence would not qualify for anticipation under

*Minnesota Min. & Mfg. Co.* Accordingly, rejection to claims 13 and 24 should be withdrawn and both claims allowed. Claims 14-23 and 25-34, being respectively dependent on claims 13 and 24, should also be allowed.

**IV. Objections to Claims 5-6, 15-16 and 26-27 as being dependent upon a rejected Base Claim**

Applicant believes he has successfully overcome the rejections against the base claims that claims 5-6, 15-16 and 26-27 depend on and respectfully requests the objections to the latter claims be withdrawn.

**CONCLUSION**

Applicant submits claims 1-34 are now allowable. If the Examiner has any questions or would like to discuss this application in more detail, please call applicant's attorney at the telephone number given below.

Respectfully submitted,

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